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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,739	10/17/2003	Michael Jared Ergo	EA-001CP1	2815

25962 7590 01/10/2006

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EXAMINER	
LABAZE, EDWYN	
ART UNIT	**PAPER NUMBER**
2876	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/688,739	ERGO ET AL.	
	Examiner	Art Unit	
	EDWYN LABAZE	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-79 and 117-122* is/are pending in the application.

4a) Of the above claim(s) *80-116* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-79 and 117-122* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of applicant's election of claims 1-79 and 117-122 filed on 11/05/2005. Claims 80-116 are withdrawn from consideration.

Obviousness-Type Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-79 and 117-122 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,655,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claims are expressly found in the claimed application. For instance, claim 117 of the present application recites the following limitations.

A method of temporarily providing digital content to a customer, comprising receiving a request from the customer comprising an indication of a desired digital content and an indication

of a desired version of the desired digital content; at a point of sale, providing a writeable optically-readable medium, wherein the medium comprises a changeable portion that, when activated, is adapted to physically change over a period of time to a degree that at least part of the medium becomes unreadable by an optical media reading machine; at the point of sale, writing the desired version of the desired digital content on the medium; and providing the medium with the desired version of the desired digital content written thereon to the customer.

Whereas in '580 application, the applicant claims:

A method for providing a rented video on an optically readable medium, the method comprising: receiving a request for the rented video; at a point of sale, writing video content on the optically readable medium; at the point of sale, treating the optically readable medium with an opaquing layer, the opaquing layer designed to render the optically readable medium unreadable after a period of time; and at the point of sale, providing the rented video on the optically readable medium to a customer.

Therefore, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to employ the teachings of claims 1-21 of '580 Patent to provide a customer at point-of-sale a requested rented digital content {or a video, DVD, movies, music and the like} having a protective layer {also stated a changeable portion, a removable protective cover} adapted to physically change over a period of time and render the medium unusable. The instant claims obviously encompass the claimed invention of '580 patent and differ only by terminology. To the extent that the present claims are broaden and therefore generic to the claimed invention of '853 application, In re Goodman 29 USPQ 2d 2010 CAFC 1993.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the application term by prohibiting claims in a second application not patentably distinct from claims of a first application. *In re Vogel*, 164 USPQ 619 (CCPA 1970).

Allowable Subject Matter

4. Claims 1- 79 and 117-122 would be allowable upon the timely filing of a **terminal disclaimer**.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken alone or in combination with any other reference, fails to teach or suggest a method for providing a requested rented video at point-of-sale on the optically readable medium, wherein at point of sale treating the optically readable medium with an protective cover when activated produce a physical change that renders the optical readable medium unreadable after a period of time, wherein the desired digital content is written on the medium and the protective cover is adapted to inhibit activation of the changeable portion of the medium when operably installed. These limitations in conjunction with other limitations in the claimed invention were not shown by the prior art of record.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Scott (U.S. 5,523,551) discloses vending apparatus and system for automated dispensing of disks.

Lee et al. (U.S. 6,950,941) teaches copy protection system of portable storage media.

Okamoto (US 2003/0135467) discloses rental system of digital content.

Wisnudel et al. (U.S. 2005/0049931) teaches digital content kiosk and associated methods for delivering selected digital content to a user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
January 7, 2006

THIEN M. LE
PRIMARY EXAMINER